

## REMARKS

Claim 18 has been amended. Claims 18, 20-23 and 28 are still pending.

### 1. Obviousness-Type Double Patenting

Claims 18, 20-23 and 28 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over certain claims of U.S. Patent Nos. 6,604,537, 6,209,557, 5,778,915, 5,579,799, 5,560,385 and 6,851,439. In response, even though Applicant does not agree with these rejections, Applicant will submit a terminal disclaimer for U.S. Patent Nos. 6,604,537, 6,209,557, 5,778,915 and 6,851,439 after the other substantive rejections have been overcome. However, Applicant respectfully traverses the obviousness-type double patenting rejection based on U.S. Patent Nos. 5,579,799 ("the '799 patent") and 5,560,385 ("the '385 patent") as follows.

First, page 800-21 of the August 2005 revision of the MPEP (copy attached hereto) states that:

"[a] double patenting rejection of the obviousness-type is 'analogous to [a failure to meet] the obviousness requirement of 35 U.S.C. 103' except that the patent principally underlying the double patenting rejection is not considered prior art. In re Braithwaite, 379 F.2d 594, 154 USPQ 29 (CCPA 1967). Therefore, any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination."

As a result, the factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966) are employed, and "are summarized as follows:

(A) Determine the scope and content of a patent claim relative to a claim in the application at issue;

(B) Determine the differences between the scope and content of a patent claim as determined in (A) and the claim in the application at issue;

(C) Determine the level of ordinary skill in the pertinent art; and

(D) Evaluate any objective indicia of nonobviousness."

That same page of the MPEP goes on to state that "[a]ny obviousness-type double patenting rejection should make clear:

(A) The differences between the inventions defined by the conflicting claims - a claim in the patent compared to a claim in the application; and

(B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue would have been an obvious variation of the invention defined in a claim in the patent."

Finally, page page 800-28 of the August 2005 revision of the MPEP (copy attached hereto) states that:

"... a double patenting rejection must rely on a comparison with the claims in an issued ... patent ...".

Applicant respectfully submits that an obviousness-type double patenting rejection of independent claim 18 based on the '799 and '385 patents cannot be sustained if the above-quoted principles are applied. On pages 3-4 of the Office Action, the Examiner points out the **similarities** between claim 18 and the claims of the '799 and '385 patents. However, as pointed out below, the Examiner fails to identify the numerous **differences** between claim 18 and the claims of the '799 and '385 patents (as required by the MPEP).

In addition, the Examiner has failed to provide reasons why a person of ordinary skill in the art would conclude that the invention defined in claim 18 would have been an obvious variation of the invention defined in the claims of the '799 and '385 patents.

a. USP 5,579,799

Following the guidelines outlined in the MPEP, it is necessary to first identify the differences between the inventions defined by claims 1 and 9 of the '799 patent compared to claim 18 of the present application.

In this regard, claims 1 and 9 of the '799 patent recite a collapsible structure having at least **three side panels** that are **connected via adjacent sides** to form an enclosed interior space. In contrast, claim 18 of the present application only recites **two** members (or panels).

In addition, claim 18 recites the following limitations that are different from (or not found in) claims 1 and 9 of the '799 patent:

- i. a collapsible structure having a side member **connected at its bottom side** to a first side of a **base** member;

- ii. **flat** members;
- iii. the base member rests on a surface when the structure is in the deployed configuration; and
- iv. the base member and the side member are connected to each other at an **acute angle**.

Claims 1 and 9 of the '799 patent are silent about flat panels and base panels, and are also silent about any connections at an acute angle. In addition, claim 18 of the present application does not recite the enclosing of any interior space.

Thus, there are numerous differences between claims 1 and 9 of the '799 patent and claim 18 of the present application.

Continuing to apply the guidelines outlined in the MPEP, it is then necessary to explain why a person of ordinary skill in the art would conclude that the invention defined in claim 18 would have been an obvious variation of the invention defined in claims 1 and 9 of the '799 patent. Here, the person of ordinary skill in the art would need to find it obvious to convert a collapsible structure having at least **three side** panels that are **connected via adjacent sides**, into a structure having (i) a base member and a side member that are connected to each other at an **acute angle**, and (ii) with the base member resting on a surface when the structure is in the deployed configuration. Applicant respectfully submits that these two contrasting structures are so different that the only way for a person of ordinary skill in the art to conclude that the invention defined in claim 18 would have been an obvious variation of the invention defined in claims 1 and 9 of the '799 patent would have been through the use of impermissible hindsight reconstruction. The numerous differences (as identified above) make it impossible for a person of ordinary skill in the art to conclude that the invention defined in claim 18 would have been an obvious variation of the invention defined in claims 1 and 9 of the '799 patent.

b. USP 5,560,385

Following the guidelines outlined in the MPEP, it is necessary to first identify the differences between the inventions defined by claim 1 of the '385 patent compared to claim 18 of the present application.

Claim 1 of the '385 patent recites a collapsible structure having at least three **side** panels that are **connected via adjacent left and right sides**, with each side panel having a **square** configuration, and **each side panel having a bottom side that is adapted to rest on a surface** to support the structure. In contrast, claim 18 of the

present application only recites **two** members (or panels) that are not even connected to each other along their left and right sides.

Claim 18 also recites the following limitations that are different from (or not found in) claim 1 of the '385 patent:

- i. a collapsible structure having a side member **connected at its bottom side** to a first side of a **base** member;
- ii. **flat** members;
- iii. the base member rests on a surface when the structure is in the deployed configuration; and
- iv. the base member and the side member are connected to each other at an **acute angle**.

In addition, claim 18 of the present application does not provide a bottom side for each side panel that rests on a surface to support the structure. Claim 1 of the '385 patent is silent about flat panels and base panels, and is also silent about any connections at an acute angle. In addition, claim 18 of the present application does not recite square panels or members.

Thus, there are numerous differences between claim 1 of the '385 patent and claim 18 of the present application.

Continuing to apply the guidelines outlined in the MPEP, it is then necessary to explain why a person of ordinary skill in the art would conclude that the invention defined in claim 18 would have been an obvious variation of the invention defined in claim 1 of the '385 patent. Here, the person of ordinary skill in the art would need to find it obvious to convert a collapsible structure having at least three **side** panels that are **connected via adjacent left and right sides**, with each side panel having a **square** configuration, into a structure having (i) a base member and a side member that are connected to each other at an **acute angle**, and (ii) with the base member resting on a surface when the structure is in the deployed configuration. Applicant respectfully submits that these two contrasting structures are so different that the only way for a person of ordinary skill in the art to conclude that the invention defined in claim 18 would have been an obvious variation of the invention defined in claim 1 of the '385 patent would have been through the use of impermissible hindsight reconstruction. The numerous differences (as identified above) make it impossible for a person of ordinary skill in the art to conclude that the invention defined in claim 18 would have been an obvious variation of the invention defined in claim 1 of the '385 patent.

\* \* \*

Thus, claim 18 of the present application is quite different, and patentably distinct, from the claims of the '799 and '385 patents. Claim 18 of the present application recites a structure that is both different, and patentably distinct, from the structures recited in the claims of the '799 and '385 patents, because the respective structures are based on a different number of basic panels (two versus at least three). There are many other limitations (see (i)-(iv) above) that are present in claim 18 that are not present in the claims of the '799 and '385 patents. There are also many limitations (see above) that are present in the claims of the '799 and '385 patents that are not found in (and which are irrelevant to) claim 18. Thus, Applicant respectfully submits that it would not be obvious to modify the claims in the '799 and '385 patents to include these limitations.

In light of the above reasons, withdrawal of the obviousness-type double patenting rejection based on the '799 patent and the '385 patent is respectfully requested.

2. USP 5,411,046 to Wan ("Wan")

Claims 18, 20-23 and 28 stand rejected under 35 USC 102(b) as being anticipated by Wan. This rejection is respectfully traversed.

First, independent claim 18 recites a base member and a side member. Wan does not have any base member, since Wan's tent has four side wall panels that are connected to each other to form a tent. When Wan's tent is deployed for use as shown in FIG. 3A, there is no base member.

In addition, claim 18 has been amended to recite that the side member and the base member are connected to each other at an acute angle. Even if one of the side panels in Wan is placed on a floor (which Applicant submits is not an appropriate interpretation, see below), this would still not yield all the limitations of claim 18 since none of the side panels are connected to an adjacent panel at an acute angle. If one of the side panels in Wan is placed on a floor, the opposing side panel will be a roof, and the other two side panels will be generally vertical (i.e., perpendicular to the base and roof panels).

The Examiner's attempt to read claim 18 on to the Wan tent is based on the underlying premise that one of the side panels of Wan can be placed on the floor. However, as explained below, there is no reason, or incentive, for a person skilled in the art to place one of the side panels of the Wan tent on the floor.

First, the "acute angle" recitations in claim 18 are specifically directed to the claimed structure being in the deployed configuration. However, the Wan tent cannot be

deployed for use as a tent if one of its side panels is placed on a floor because the entire structure would be tilted to one side, and therefore be very unstable. In fact, it would be dangerous for an individual to enter the interior of the Wan tent when one of its side panels is placed on a floor. Therefore, why would a person skilled in the art want to place one of the side panels of the Wan tent on the floor?

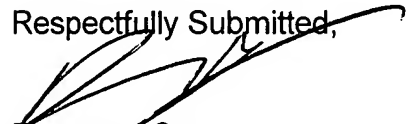
Second, even ignoring the notions of danger, placing one of the side panels of the Wan tent on the floor would result in the open bottom now forming an opened side. As such, the tent can no longer serve any useful purpose. For example, it cannot function effectively as a tent since it will have one side that is completely exposed to the environment.

Thus, there is no teaching, suggestion, logical reason or incentive why a person skilled in the art would even desire to place one of the side panels of the Wan tent on the floor. For this reason, the Examiner's underlying premise is based on impermissible hindsight reconstruction.

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In light of the above, it is respectfully submitted that all pending claims are in condition for allowance. The Examiner is encouraged to phone the undersigned if the Examiner has any amendments or suggestions for putting this application in condition for allowance.

Respectfully Submitted,

  
Raymond Sun  
Attorney for Applicant  
12420 Woodhall Way  
Tustin, CA 92782  
Tel: 949-252-9180

**CERTIFICATE OF MAILING**

I hereby certify that this paper and its enclosures are being deposited with the United States Postal service as First Class Mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

Date: November 29, 2005

By:

  
Raymond Sun

additionally be made in the later-filed application using form paragraph 7.15.01.

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If the “same invention” is not being claimed twice, an analysis must be made to determine whether a non-statutory basis for double patenting exists.

### B. Nonstatutory Double Patenting

A rejection based on nonstatutory double patenting is based on a judicially created doctrine grounded in public policy so as to prevent the unjustified or improper timewise extension of the right to exclude granted by a patent. *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re White*, 405 F.2d 904, 160 USPQ 417 (CCPA 1969); *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968); *In re Sarett*, 327 F.2d 1005, 140 USPQ 474 (CCPA 1964).

#### 1. Obviousness-Type

In determining whether a nonstatutory basis exists for a double patenting rejection, the first question to be asked is — does any claim in the application define an invention that is merely an obvious variation of an invention claimed in the patent? If the answer is yes, then an “obviousness-type” nonstatutory double patenting rejection may be appropriate. Obviousness-type double patenting requires rejection of an application claim when the claimed subject matter is **not patentably distinct** from the subject matter claimed in a commonly owned patent>, or a non-commonly owned patent but subject to a joint research agreement as set forth in 35 U.S.C. 103(c)(2) and (3),< when the issuance of a second patent would provide unjustified extension of the term of the right to exclude granted by a patent. See *Eli Lilly & Co. v. Barr Labs., Inc.*, 251 F.3d 955, 58 USPQ2d 1869 (Fed. Cir. 2001); *Ex parte Davis*, 56 USPQ2d 1434, 1435-36 (Bd. Pat. App. & Inter. 2000).

A double patenting rejection of the obviousness-type is “analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. 103” except that the patent principally underlying the double patenting rejection is not considered prior art. *In re Braithwaite*,

379 F.2d 594, 154 USPQ 29 (CCPA 1967). Therefore, any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination. *In re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985).

Since the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. 103(a) rejection, the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are employed when making an obvious-type double patenting analysis. These factual inquiries are summarized as follows:

- (A) Determine the scope and content of a patent claim \*\* relative to a claim in the application at issue;
- (B) Determine the differences between the scope and content of the patent claim \*\* as determined in (A) and the claim in the application at issue;
- (C) Determine the level of ordinary skill in the pertinent art; and
- (D) Evaluate any objective indicia of nonobviousness.

The conclusion of obviousness-type double patenting is made in light of these factual determinations.

Any obviousness-type double patenting rejection should make clear:

- (A) The differences between the inventions defined by the conflicting claims — a claim in the patent compared to a claim in the application; and
- (B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim \*\*>at issue would have been< an obvious variation of the invention defined in a claim in the patent.

When considering whether the invention defined in a claim of an application \*>would have been< an obvious variation of the invention defined in the claim of a patent, the disclosure of the patent may not be used as prior art. >*General Foods Corp. v. Studiengesellschaft Kohle mbH*, 972 F.2d 1272, 1279, 23 USPQ2d 1839, 1846 (Fed. Cir. 1992).< This does not mean that one is precluded from all use of the patent disclosure.

7. A provisional double patenting rejection should also be made in the conflicting application.

8. If evidence shows that either application is prior art unto the other under 35 U.S.C. 102(f) or (g) and the copending application has not been disqualified (as prior art in a 103 rejection based on common ownership), a rejection should additionally be made in the other application under 35 U.S.C. 102(f)/103(a) or 102(g)/103(a) using form paragraph 7.21, unless the patent is disqualified under 35 U.S.C. 103(c) as prior art in a 35 U.S.C. 103(a) rejection.

9. If the disclosure of one application may be used to support a rejection of the other and the applications have different inventive entities and different U.S. filing dates, use form paragraph 7.21.01 to additionally make a rejection under 35 U.S.C. 102(e)/103(a) in the application with the later effective U.S. filing date. For applications pending on or after December 10, 2004, rejections under 35 U.S.C. 102(e)/103(a) should not be made or maintained if the patent is disqualified under 35 U.S.C. 103(c) as prior art in a 35 U.S.C. 103(a) rejection.

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### 3. Design/Plant — Utility Situations

Double patenting issues may be raised where an applicant has filed both a utility patent application (35 U.S.C. 111) and either an application for a plant patent (35 U.S.C. 161) or an application for a design patent (35 U.S.C. 171). In general, the same double patenting principles and criteria that are applied in utility-utility situations are applied to utility-plant or utility-design situations. Double patenting rejections in utility-plant situations may be made in appropriate circumstances.

Although double patenting is rare in the context of utility versus design patents, a double patenting rejection of a pending design or utility application can be made on the basis of a previously issued utility or design patent, respectively. *Carman Indus. Inc. v. Wahl*, 724 F.2d 932, 220 USPQ 481 (Fed. Cir. 1983). The rejection is based on the public policy preventing the extension of the term of a patent. Double patenting may be found in a design-utility situation irrespective of whether the claims in the patent relied on in the rejection and the claims in issue involve the same invention, or whether they involve inventions which are obvious variations of one another. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

In *Carman Indus.*, the court held that no double patenting existed between a design and utility patent since the claims in the utility patent, drawn to the interior construction of a flow promoter, were not directed to the same invention or an obvious variation of the invention claimed in a design patent directed to the

visible external surface configuration of a storage bin flow promoter. The majority opinion in this decision appears to indicate that a two-way obviousness determination is necessary in design-utility cases. 724 F.2d at 940-41, 220 USPQ at 487-88. But see *Carman Indus.* (J. Nies, concurring).

In *Thorington*, the court affirmed a double patenting rejection of claims for a fluorescent light bulb in a utility patent application in view of a previously issued design patent for the same bulb. In another case, a double patenting rejection of utility claims for a finger ring was affirmed in view of an earlier issued design patent, where the drawing in both the design patent and the utility application illustrated the same article. *In re Phelan*, 205 F.2d 183, 98 USPQ 156 (CCPA 1953). A double patenting rejection of a design claim for a flashlight cap and hanger ring was affirmed over an earlier issued utility patent. *In re Barber*, 81 F.2d 231, 28 USPQ 187 (CCPA 1936). A double patenting rejection of claims in a utility patent application directed to a balloon tire construction was affirmed over an earlier issued design patent. *In re Hargraves*, 53 F.2d 900, 11 USPQ 240 (CCPA 1931).

### III. CONTRAST BETWEEN DOUBLE PATENTING REJECTION AND REJECTIONS BASED ON PRIOR ART

Rejections over a patent or another copending application based on double patenting or 35 U.S.C. 103(a) are similar in the sense that both require comparison of the claimed subject matter with at least part of the content of another patent or application, and both may require that an obviousness analysis be made. However, there are significant differences between a rejection based on double patenting and one based on 35 U.S.C. 102(e) prior art under 35 U.S.C. 103(a). *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991).

One significant difference is that a double patenting rejection must rely on a comparison with the claims in an issued or to be issued patent, whereas an obviousness rejection based on the same patent under 35 U.S.C. 102(e)/103(a) relies on a comparison with what is disclosed (whether or not claimed) in the same issued or to be issued patent. In a 35 U.S.C. 102(e)/103(a) rejection over a prior art patent, the reference patent is available for all that it fairly discloses to one of ordinary skill in the art, regardless of what is